

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. HESS and SCOTT L. SULLIVAN

Appeal No. 97-0064
Application No. 08/286,785¹

ON BRIEF

Before KRASS, JERRY SMITH, and GROSS, Administrative Patent Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 16, which are all of the claims pending in this application.

The appellants' invention relates to a pill with a micro barcode containing identification and/or medical information

¹ Application for patent filed August 5, 1994.

concerning the pill and also a method and device for retrieving the information from the micro barcode.² Claims 1 and 5 are illustrative of the claimed invention, and they read as follows:

1. A pill on which is imprinted micro barcode, said micro barcode containing information pertaining to any one of medication contents of the pill and source identification of the pill.

5. A device for retrieving information encoded on a micro barcode imprinted on a pill and indicating the retrieved information to a user, comprising:

means for scanning the micro barcode on the pill to retrieve information encoded in the micro barcode;

means for interpreting the scanned micro barcode; and

means responsive to results of interpretation by said interpreting means for indicating information encoded in the micro barcode in a manner understandable to the user.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wittwer	4,478,658	Oct. 23, 1984
Shamir	5,118,369	Jun. 02, 1992
Aurenus ³	5,129,974	Jul. 14, 1992

Claims 1 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wittwer in view of Shamir or Aurenus.

Reference is made to the Examiner's Answer (Paper No. 15, mailed June 27, 1996) for the examiner's complete reasoning in

² Appellants may find U.S. Patent 5,700,998 to Palti to be of interest.

³ Since the disclosures of Shamir and Aurenus are virtually the same, only Shamir will be discussed in this opinion.

support of the rejections, and to the appellants' Brief (Paper Nos. 13 and 20, filed January 16, 1996 and April 8, 1999, respectively) and Reply Brief (Paper No. 16, filed July 29, 1996) for the appellants' arguments thereagainst.

OPINION

As a preliminary matter, we note that appellants state on page 4 of the Brief that "each claim is believed to contain patentable subject matter in its own right and should not be grouped together." For the next four pages appellants reproduce the limitations recited in each claim. Also, in the paragraph bridging pages 22 and 23, appellants group claims 4, 10, and 16; claims 5 and 11; claims 6, 7, 12, and 13; and claims 3, 8, 9, 14, and 15; and for each group state that the references do not teach the particular additional limitation. However, appellants have not presented arguments in accordance with 37 CFR § 1.192(c)(7) (1995).⁴ Accordingly, we will consider all of the claims as grouped together, with claim 1 as representative.

⁴ "For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable" (underlining added for emphasis).

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by the appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1 through 16.

The examiner combines Wittwer and Shamir to reject all of the claims. Wittwer discloses (column 9, lines 19-20) "imprinting of logos, codes or the like may be placed on the visible surface of the label." The examiner focuses on those two lines (Final Rejection, page 5) as "the incentive for labelling capsules using small labels." Shamir teaches (column 4, lines 42-44) that "microlabels may be utilized in any application in which product identification requires exceedingly small labels." The examiner concludes (Final Rejection, page 5) that since Wittwer teaches using small labels, and Shamir teaches using microlabels for small labels, "it would have been an obvious expedient for one with ordinary skill in the art to attach the micro-labels as taught by Shamir [or Aurenus] to the capsules."

There are two problems with the examiner's conclusion. First, the end of the paragraph in Wittwer states (column 9, lines 31-39):

The application of indicia by imprinting provides a further visual characteristic that enhances the tamper-evident capabilities of the seal. As difficult as it is to cosmetically reconstruct a fractured seal, so much more so is the reconstruction of a fractured logo to assure alignment, continuity, etc. Imprinting,

therefore, serves as a valuable additional step that enhances the tamper-evident qualities of the capsule seal prepared by the present invention.

In other words, the code or logo in Wittwer must be visible, as it must assist in assuring alignment. The examiner asserts (Answer, page 4), "[a]lthough the presence of the codes on the label would enhance tampering evidence, this is just considered as an additional benefit of printing the codes on the label's surface. The codes, themselves, have several old and known utilities such as containing useful information for identification purposes." The examiner's reasoning, however, is backwards; the presence of the codes is specified as being for enhancing tampering evidence, and any utility such as for identification purposes would be the additional benefits. As explained by appellants (Brief, page 16), to print a micro barcode, which would not be visible to the human eye, would "frustrate Wittwer's goal in promoting anti-tampering through visual inspection of the label itself with the human eye."

Second, the examiner has skipped a step in combining the references. For Shamir to be applied, the primary reference must include "product identification [which] requires exceedingly small labels" (Shamir, column 4, lines 42-44, underlining added for emphasis). While it is true that the capsules of Wittwer use small labels, as explained by appellants (Brief, page 11),

"Wittwer uses labels strictly for anti-tampering purposes; product identification is not even a consideration." Although one could view product identification as being encompassed by "logos, codes or the like," Wittwer specifies that the codes or logos must remain visible. Therefore, they cannot be exceedingly small. Accordingly, Shamir is not applicable and, as such, not properly combinable with Wittwer.

In addition, the examiner states (Final Rejection, page 6) that "[a]s to the claimed medication contents of the pills, it is respectfully submitted that the use of a regular size label having the contents and the source identification of the medicine is notoriously well known." We agree that such information is generally included on a label on the medicine bottle. However, we cannot agree with the examiner's conclusion that "it would have been an obvious expedient for one with ordinary skill in the art to print the information on a micro-barcode label with art recognized equivalent," without some evidence showing either the need to have such information on each pill or the equivalence of providing the information on the bottle with having it on each pill. The examiner's "further motivation" (Final Rejection, page 6) for moving the information to the individual pill, i.e., to "prevent fraudulent [sic] in the case that the contents of the pills are considered critical" comes straight from appellants'

specification without any suggestion in the prior art, and therefore does not provide a proper basis for obviousness.

"There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself." See In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

The examiner further states (Answer, page 8) that "if one has decided to go from visual verification to machine verification, there is no desire to maintain the size of Wittwer's label." We agree that labels that are to be read by machine generally do not need to be visible to the human eye. However, in the present case, the examiner has presented no rationale for moving to machine verification. Further, as the purpose of Wittwer is visual verification, changing the size and switching to machine verification would be contrary to the teachings of the primary reference. Accordingly, we cannot sustain the obviousness rejection of claim 1 and its dependents, claims 2 through 4. Further, since each of claims 5 and 11 includes the limitation of a micro barcode imprinted on a pill, we must reverse the obviousness rejection of claims 5, 11, and their dependents, claims 6 through 10 and 12 through 16.

Appeal No. 97-0064
Application No. 08/286,785

CONCLUSION

The decision of the examiner rejecting claims 1 through 16
under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

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